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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/143,343	08/28/1998	MARK A. BOYS	P644	3403

24739 7590 12/11/2001

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EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 12/11/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/143,343

Applicant(s)

BOYS, MARK A.

Examiner

Thai Tran

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. The request for a continued prosecution application (CPA) under 37 CFR 1.53(d) filed on Nov. 27, 2001 is acknowledged. 37 CFR 1.53(d)(1) was amended to provide that the prior application of a CPA must be: (1) a utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, (2) a design application, or (3) the national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000. See *Changes to Application Examination and Provisional Application Practice*, interim rule, 65 *Fed. Reg.* 14865, 14872 (Mar. 20, 2000), 1233 *Off. Gaz. Pat. Office* 47, 52 (Apr. 11, 2000). Since a CPA of this application is not permitted under 37 CFR 1.53(d)(1), the improper request for a CPA is being treated as a request for continued examination of this application under 37 CFR 1.114. See *id.* at 14866, 1233 *Off. Gaz. Pat. Office* at 48.

Response to Arguments

2. Applicant's arguments with respect to claims 1-4 and 17-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 17-20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lynch et al ('423).

Regarding claim 1, Lynch discloses a perpetual recording device coupled with a conventional media presentation device (the FIGURE) having an input port (16 of the FIGURE, col. 2, lines 20-29) for accepting media from the media presentation device; at least one recording mechanism (16 of the FIGURE, col. 2, lines 20-29) associated with at least one data store facility for recording and optional transfer of the recorded media for store; a user interface (26 and 28 of the FIGURE, col. 2, lines 30-43) for controlling the function of recording and for enabling functions of media transfer, store, and playback of recorded media; an output port (18 and 20 of the FIGURE, col. 2, lines 20-29) for enabling throughput of the media to a speaker system and optional visual display apparatus associated with the media presentation device; and a user input (28 of the FIGURE, col. 2, line 44 to col. 3, line 38) on the user interface for inserting a flag-set into the recorded media, the flag-set searchable and usable as indicia for beginning a playback session of recorded media at a desired point in the recording sequence the playback ending at a desired point in the recording sequence or the selecting a media portion of the recorded media for permanent storage.

Regarding claim 2, Lynch et al also discloses the claimed an RF radio or a television (col. 2, lines 20-29).

Regarding claim 3, Lynch et al discloses the claimed an analog to digital converter and wherein the at least one data store is a write able digital memory accepting data writes comprising digitally recorded media (col. 2, lines 9-22).

Regarding claim 4, the claimed a complete song or a block of completed songs is an inherent characteristic of the television signal disclosed in col. 2, lines 9-22 because the television signal has song.

Regarding claim 17, Lynch discloses the claimed wherein coupling results in internalizing the device into the circuitry of the media presentation device (the FIGURE).

The method claims 18-19 are rejected for the same reasons as discussed in the apparatus claims 1-2.

Regarding claim 19, Lynch et al discloses the claimed wherein in step (c) the flag-set marks the beginning and end of a desired block of media (col. 3, lines 22-38).

Regarding claim 22, Lynch et al discloses the claimed wherein in step (d) the indicia is a memory button that searches for the set flags automatically (col. 3, lines 1-21).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch et al ('423) in view of Ichinose ('569).

Lynch et al discloses all the features of the instant invention except for providing as discussed in claim 18 above except for providing that in step (d) the indicia is a jogging wheel manually operated to search the flag-sets.

Ichinose teaches a video editing viewer having a jogging wheel (6 of Fig. 1, col. 2, lines 14-39) for selecting an editing point.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the rotary knob 6 of Ichinose into Lynch et al's system in order to facilitate the processing of searching the flag-sets.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

TTQ
December 7, 2001


THAI TRAN
PRIMARY EXAMINER